

REMARKS

Formal Matters

Claim 28 is pending after entry of the amendments set forth herein.

Claim 28 has been amended to more particularly point out and distinctly claim the invention. The amendment to claim 28 is supported at numerous places in the specification and is specifically supported at page 6, paragraph no. 037 which clearly indicates that the peptides of the invention are included in pharmaceutical compositions and they are capable of inhibiting angiogenesis and useful for treating or preventing various diseases associated with angiogenesis. Specific diseases are provided and still further on page 11 beginning at paragraph 059 and continuing to page 12 at paragraph 064 applications have disclosed specific amounts which would be useful in providing an angiogenesis inhibitory effect. Accordingly, the amendment is fully supported within the originally filed application. This amendment is not believed to add new issues which would require further searching by the Examiner in that applicants had previously claimed the peptide in a carrier. Still further, in an earlier claim which was examined specific information relating to the concentration of the peptide in the carrier was put forth. In view of such applicants respectfully request entry of the amendment.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

Formal Objection to Oath/Declaration

The original Declaration submitted by applicants was objected to. Applicants have attached hereto a copy of a Supplemental Declaration, the original of which was previously submitted to the Patent Office. The Supplemental Declaration clearly includes the correct address with the inventors' signatures and date in place with no changes made in the address. The date of the Supplemental Declaration is October 6, 2001 which is clearly after the original Declaration which was signed and dated on August 29, 2001. In view of such the objection is believed to have been overcome.

Rejection under 35 U.S.C. §103

Claim 28 was rejected under 35 U.S.C. §103 as unpatentable over the combination of Choh Li and Mark et al. The rejection is traversed as applied and as it might be applied to the presently pending

amended claim 28. The rejection has referred to Choh Li at col. 4, line 8 in support of the use of a pharmaceutically acceptable carrier. The use of 0.1 molar tris buffer at a pH of 8.2 is not a pharmaceutically acceptable carrier. Further, there is no disclosure within Choh Li suggesting that a peptide such as the peptide of SEQ ID NO.:18 should be placed within a pharmaceutically acceptable carrier.

The rejection has recognized that Choh Li does not disclose the sequence of SEQ ID NO.:18. However, the rejection argues that it would be obvious to modify the sequence of Choh Li in view of the various mutagenesis techniques disclosed by Mark et al. in order to obtain a compound of SEQ ID NO.:18. Applicants acknowledge that it would be possible to carry out mutagenesis on proteins to result in different proteins and that if the correct mutagenesis techniques were applied at the right positions one could obtain a sequence such as SEQ ID NO.:18. However, there are very large numbers of possibilities in terms of carrying out the mutagenesis. The mere reference to the presence of a cysteine residue at col. 7, line 32 of Choh Li is insufficient motivation to produce such a protein and further to produce such as protein having an expectation that the protein should have a desirable therapeutic effect. Applicants have claimed the protein within the pharmaceutically acceptable carrier and specifically claimed the protein should be present in an angiogenesis inhibitory amount. The cited art does not suggest that the protein having the SEQ ID NO.:18 would have an antgenesis inhibitory effect. Thus, it is applicants' position that even if a *prima facie* is presented the *prima facie* case is overcome by providing the angiogenesis inhibitory effect.

The rejection has argued that properties of a compound would be expected absent evidence to the contrary. However, there is no prior art suggesting that such a compound would have an inhibitory effect on angiogenesis. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

It is applicants' position that the original Declaration as well as the Substitute Declaration are sufficient to comply with the rules and that the objection has been overcome.

Claim 28 has been amended and support for the amendment pointed out. The Choh Li patent does not disclose the sequence of SEQ ID NO.:18 and does not disclose that modifications of such would result in providing an inhibitory effect on angiogenesis. Further, Choh Li does not teach the presence of the protein in a pharmaceutically acceptable carrier. Although Mark et al. teaches mutagenesis technology there are extremely large numbers of possibilities whereby mutagenesis could

be carried out and the teachings within Mark et al. and Choh Li et al. combined are insufficient to teach towards the specific mutagenesis technique which would have to be carried out to obtain the sequence of SEQ ID NO.:18. In view of such reconsideration and withdrawal of the rejection is respectfully requested.

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number UCSF-264CON.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: _____

15/August/03

By: _____

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Attachments: Declaration and Supplemental Declaration